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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/784,116	02/20/2004	Gerold Winkler	8470G-000016	5270

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EXAMINER

SCHWARTZ, CHRISTOPHER P

ART UNIT	PAPER NUMBER
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3683

DATE MAILED: 04/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/784,116

Applicant(s)

WINKLER ET AL.

Examiner

Christopher P. Schwartz

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Applicant's response filed 1/7/05 has been received and considered. The drawing objections have been overcome. However, no amendment to the claims was made.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 1,3-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Leibach in view of Fukahori et al.

Regarding claim 1 Leibach discloses in figure 3 a device, which if turned upside, closely resembles the design of applicant's. Note the support bearing at 1,2 and end

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bearing 4, spring element 3 which is "resistant" to high temperatures- as broadly claimed, and fluid chambers 8 and 9.

Leibach lacks a protective coating applied to the spring element 3.

However, it is notoriously well known in the art to bond (adhesively or otherwise) protective elastomeric layers to other spring elements to increase their resistance to the corrosive effects of their particular environment of use or to alter the spring constant thereof.

The reference to Fukahori et al. discloses it is known to use silicone based rubber and NR rubber in vibration mount applications. Note the discussion of the EPDM coated NR rubber in column 14. Note the specific rubber compounds which may be used in the device as discussed in column 7 lines 43+.

One having ordinary skill in the art at the time of the invention would have found it obvious to have applied a protective coating to the rubber spring element of Leibach, as taught by Fukahori et al. for increased resistance to cracking and/or protection from the environment.

Regarding claim 3, as broadly claimed, and as can be seen in the drawings these requirements are met.

Regarding claims 4 and 5 because many types of bonding rubber coatings to rubber elements are notoriously well known in the art dependent upon such well known factors as manufacturing costs, resistance to environmental conditions, and complexity of manufacture one having ordinary skill in the art would have found it an obvious design choice of whether to use adhesive or not.

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Regarding claims 6-7 it would have been obvious to have coated the entire surface of the spring element with an EPDM coating for maximum protection.

Regarding claims 9-11 the ratio of a thickness of the spring element 3 at it's thickest point to the thickness of the protective layer in Leibach as modified, of at least 2, as claimed, would have been an obvious selection to maximize the wear and fatigue properties of the spring element 3 for a specific application.

5. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Leibach in view of Fukahori et al. as applied to claim 1 above, and further in view of Vernier.

Regarding claim 2 Leibach as modified above lacks specifically using a silicone elastomer for the spring element 3.

Fukahori et al. teaches (as discussed previously) such a rubber is known to be used in damping applications. See column 7 lines 43+.

The reference to Vernier shows such a silicone based rubber may be used for element 7. See column 3 lines 5+.

Simply dependent upon the spring characteristics desired from the mount of Leibach one having ordinary skill in the art at the time of the invention would have found it obvious to have used silicone rubber for the spring element 3 of Leibach since such rubber is well known and widely used in these applications.

Response to Arguments

6. Applicant's arguments filed 1/7/05 have been fully considered but they are not persuasive. The examiner maintains that one having ordinary skill in the art at the time of the invention would have found it obvious to have arrived at applicant's claimed

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invention for the reasons outlined in the action above. The prior art cited but not relied upon shows it is notoriously well known in the art to use spring elements having "protective layers" in the automotive industry.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The references cited have been cited for showing other examples of EPDM or silicone rubber applications.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher P. Schwartz whose telephone number is 703-308-0576. The examiner can normally be reached on M-F 9:30-6:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dave Bucci can be reached on 703-308-3668. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

3/31/05